

REMARKS

This Amendment and Response is submitted in response to the outstanding final Office Action, dated January 3, 2008. Claims 1 through 45 are presently pending in the above-identified patent application. In this response, Applicants 5 propose to amend claims 1, 4, 6, 8, 9, 16, 20, 21, 23, 25, 33, 34, 36, and 38. A Request for Continued Examination is being submitted herewith.

In the Office Action, the Examiner rejected claims 1-45 under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement, rejected claims 1-5, 10, 14-15, 18-22, 26, 30-35, 39 and 43-45 under 35 U.S.C. §103(a) 10 as being unpatentable over Miller et al (United States Patent Publication No. 2002/0026369) in view of Goldberg et al. (United States Patent No. 6,985,885), and rejected claims 6-9, 11-13, 16-17, 23-25, 27-29, 36-38 and 40-42 under 35 U.S.C. §103(a) as being unpatentable over Miller in view of Goldberg as applied to claims 1, 20, and 33 above, and further in view of Haddawy (Haddawy, Peter. "An Overview of Some 15 Recent Developments in Bayesian Problem-Solving Techniques," AI Magazine La Canada: Summer 1999, Vol. 20, Iss. 2; pg. 11, 9 pgs).

Section 112 Rejections

Claims 1-45 were rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement and under 35 U.S.C. §112, 20 second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Regarding claims 1, 20, and 33, the Examiner asserts that the applicant did not have possession of the invention as claimed at the time of filing the application and asserts that there is no mention of how a request comprises non-textual information and analyzing the request 25 and the non-textual information to create additional information within the context of enabling an electronic information marketplace.

Applicants note that the present specification teaches a "request for locations." (Page 23, line 8.) The specification teaches how a request can comprise non-textual information (see, page 23, lines 4-12) Thus, in light of the present specification, 30 a person of ordinary skill in the art would understand how a request comprises non-

textual information. In addition, the specification describes analyzing the request and the non-textual information to create additional information within the context of enabling an electronic marketplace at page 7, line 17, to page 8, line 13; page 10, line 19, to page 13, line 10; page 17, line 9, to page 19, line 19; and page 20, line 14, to page 24, line 16.

5 Applicants also note that independent claims 1, 20, and 33 require analyzing the non-textual information to create additional information from the request.

Regarding the Examiner's assertion that there is no mention of how a request comprises non-textual information and analyzing the request and the non-textual information to create additional information within the context of enabling an electronic information marketplace, Applicants note that the present specification teaches that a request may comprise non-textual information, such as "a basic *outline* for the house." (Page 19, line 10; emphasis added.) The remaining portion of the cited paragraph (page 19, lines 10-19) describes how the non-textual information is analyzed to create additional information within the context of enabling an electronic information marketplace.

15 Thus, Applicants respectfully request that the section 112 rejections be withdrawn.

Independent Claims 1, 20 and 33

Independent claims 1, 20, and 33 were rejected under 35 U.S.C. §103(a) as being unpatentable over Miller et al. in view of Goldberg et al. Regarding claim 1, the Examiner asserts that Miller discloses collecting a request from a buyer for a requested good wherein said request comprises non-textual information. The Examiner acknowledges that Miller does not specifically disclose information goods, but asserts that Goldberg teaches a system for pricing and selling digital goods. The Examiner asserts that it would have been obvious to modify Miller to include digital goods as taught by Goldberg. The Examiner has also previously asserted that the product bar codes disclosed by Miller are scanned by a bar code reader and are used in the request from a buyer. The Examiner further asserted that the buyer may access a portal or web page and indicated his selection by clicking on an item. In the Response to Arguments section of the final Office Action, the Examiner asserts that other means (in facilitating a

non-textual request) include scanners, hand-held devices and desktop computers. The Examiner asserts that ultimately any form of the request will be transmitted and stored on a computer system using signals (Miller: paragraphs 0042-0047).

Applicants note that a bar code may be suitable for the goods disclosed by 5 Miller; a bar code is *not* suitable, however, for a system based on Miller that has been modified to *include digital goods*. For example, it is not obvious as to how a digital good can be identified by a bar code (as conventionally used), as would be apparent to a person of ordinary skill in the art. Applicants maintain that a person of ordinary skill in the art would *not* utilize a bar code in *requesting an information good, as defined in the context 10 of the present invention*. Thus, Miller and Goldberg, alone or in combination, do not disclose or suggest a *request comprising non-textual information*

Regarding the Examiner's assertion that the buyer may access a portal or web page and indicated his selection by clicking on an item, Applicants note that the items that can be "clicked on" are textual items (see, FIGS. 5A-1 to 5B-2). As previously 15 argued, Applicants note that the present specification teaches that a request can comprise information that is *not* in a textual format. For example, non-textual information includes the outline of a house (page 19, line 10), spectral bands (page 22, lines 18-24), spatial texture and/or weather pattern(s) (page 23, lines 4-12), and ground moisture (page 23, line 27, to page 24, line 5).

20 Regarding the Examiner's assertion that ultimately any form of the request will be transmitted and stored on a computer system using signals (Miller: paragraphs 0042-0047), Applicants note that Miller does not disclose or suggest any type of request that is non-textual, in the context of the present invention. In fact, Miller teaches away from the present invention by teaching that a request is a "textual request." (See, 25 Abstract.) In addition, independent claims 1, 20, and 33 have been amended to require analyzing the *non-textual information to create additional information from the request*. Miller does *not* disclose or suggest analyzing the *non-textual information to create additional information from the request*.

Thus, even as combined in the manner suggested by the Examiner, Miller 30 and Goldberg *do not teach every element of the independent claims*. Furthermore, based

on the KSR considerations discussed hereinafter, the combination/modification suggested by the Examiner is not appropriate.

KSR Considerations

5 An Examiner must establish “an apparent reason to combine . . . known elements.” *KSR International Co. v. Teleflex Inc. (KSR)*, 550 U.S. ___, 82 USPQ2d 1385 (2007). Here, the Examiner merely states that it would have been obvious to one having ordinary skill in the art to modify Miller to include digital goods as taught by Goldberg in order to provide the consumer with a varied array of products to purchase.

10 There is no suggestion in Miller or in Goldberg, alone or in combination, to analyze a non-textual information to create additional information from the request. Moreover, Miller’s teaching that the request is a “textual request” (see, Abstract) **teaches away** from the present invention. The *KSR* Court discussed in some detail *United States v. Adams*, 383 U.S. 39 (1966), stating in part that in that case, “[t]he Court relied upon the corollary principle that when the prior art teaches away from combining certain 15 known elements, discovery of a successful means of combining them is more likely to be nonobvious” (*KSR* Opinion at p. 12). Thus, there is no reason to make the asserted combination/modification.

20 Thus, Miller et al. and Goldberg et al., alone or in combination, do not disclose or suggest analyzing the non-textual information to create additional information from the request, as required by independent claims 1, 20, and 33, as amended. Applicants respectfully request withdrawal of the Section 103 rejection of the independent claims.

Additional Cited References

25 Haddaway was also cited by the Examiner for its disclosure, for example, that “any Bayesian network inference algorithm can be used.” Applicants note, however, that Haddaway does *not* address the issue of analyzing non-textual information to create additional information from the request.

30 Thus, Haddaway does not disclose or suggest analyzing the non-textual information to create additional information from the request, as required by independent claims 1, 20, and 33, as amended.

Claims 6 and 36

Claims 6 and 36 are rejected under 35 U.S.C. §103(a) as being unpatentable over Miller et al. in view of Goldberg et al., and further in view of Haddawy. In particular, the Examiner acknowledges that Miller and Goldberg do not 5 specifically disclose creating at least one inference from each of the offered information goods, but asserts that Haddaway teaches the topic of inference in Bayesian networks

Applicants note, however, that neither Miller nor Goldberg nor Haddaway discloses or suggests creating at least one inference *from offered information goods*, and that *none of the cited references* disclose or suggest combining the technique(s) of 10 Haddaway with the inventions of either Miller or Goldberg.

Thus, Miller et al., Goldberg et al., and Haddaway, alone or in combination, do not disclose or suggest creating at least one inference from each the offered information goods, as required by claims 6 and 36.

Dependent Claims 2-19, 21-32 and 34-45

15 Dependent claims 2-5, 10, 14, 15, 18, 19, 21, 22, 26, 30-32, 34, 35, 39, and 43-45 were rejected under 35 U.S.C. §103(a) as being unpatentable over Miller et al. in view of Goldberg et al., and claims 6-9, 11-13, 16, 17, 23-25, 27-29, 36-38, and 40-42 were rejected under 35 U.S.C. §103(a) as being unpatentable over Miller et al. in view of Goldberg et al., and further in view of Haddawy.

20 Claims 2-19, 21-32, and 34-45 are dependent on claims 1, 20, and 33, respectively, and are therefore patentably distinguished over Miller et al., Goldberg et al., and Haddaway (alone or in any combination) because of their dependency from amended independent claims 1, 20, and 33 for the reasons set forth above, as well as other elements these claims add in combination to their base claim.

25 All of the pending claims following entry of the amendments, i.e., claims 1-45, are in condition for allowance and such favorable action is earnestly solicited.

If any outstanding issues remain, or if the Examiner has any further suggestions for expediting allowance of this application, the Examiner is invited to contact the undersigned at the telephone number indicated below.

The Examiner's attention to this matter is appreciated.

Respectfully submitted,

/Kevin M. Mason/

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